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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/646,811	01/05/2001	Wolfgang Trinkies	BATG-5	1558

7590

02/20/2003

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EXAMINER

LOPEZ, CARLOS N

ART UNIT

PAPER NUMBER

1731

DATE MAILED: 02/20/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

ASh

Office Action Summary	Application No.		Applicant(s)	
	09/646,811		TRINKIES ET AL.	
	Examiner		Art Unit	
	Carlos Lopez		1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/15/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-15 and 26-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 and 26-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 January 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's amendment filed on 1/15/03 has been entered and obviates the Restriction requirement mailed on 11/27/02.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: element 22 in figure 1 and element 166 in figure 5. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 38 objected to because of the following informalities: at line 2 "catchment". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-15 and 26-52 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. A means for enclosing tobacco in wrapper to meet the definition of a cigarette¹ maker is critical or essential to the practice of the

¹ **cig-a-rette** also **cig-a-ret** (sîg'e-rèt', sîg'e-rèt') *noun*

1. A small roll of finely cut tobacco for smoking, enclosed in a wrapper of thin paper.

invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). A cigarette maker would include structural limitations that provide the means to make a cigarette¹, in other terms a means to enclose tobacco with a wrapper. Additionally, the limitation "do-it-yourself" implies that a user makes a cigarette but the disclosed "do-it-yourself cigarette maker" is a machine wherein the act of wrapping tobacco is made by a device not by a user, "yourself". Therefore, the claims are not enabled to be claimed as a "do-it-yourself" cigarette maker.

Claims 43 and 47-52 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not support a funnel shaped tobacco material infeed section, singling device being a roller, and a tobacco rod compression mechanism having a plucking mechanism as recited in independent claim 10 in combination with a housing having a second plucking roller, a second funnel, a tobacco chamber and a compressive pusher as recited dependant claim 47. The same deficiency is found in claim 52. It is noted that in changing the dependency of claim 47 and 52 applicant has created and claims a cigarette maker having duplicated parts that is not supported by the specification. Additionally the specification does not provide enablement for shingled scoop as recited in claim 43.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

2. A similar roll of another substance, such as a tobacco substitute or marijuana.

Art Unit: 1731

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 and 37 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 13, "said wall sections, surrounding said tobacco rods" lacks antecedent basis. In claim 37, it is unclear what intended structural limitation being claimed by reciting a hopper configured as a drawer having a bottom latticed.

Claims 10-15, 26-52 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: means for wrapping a cigarette.

Regarding claim 12, the word "means" is preceded by the word(s) "of a positioner" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Additionally, it can't be ascertained if applicant when using the term "preferably" is claiming "means of a positioner". Clarification is needed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 10-11, 14, 27, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josuttis et al (US 4,572,216) in view of Hurt (US 4,164,229). Josuttis discloses a cigarette maker having a funnel shaped infeed section, hopper 1' and a singling plucking roller having pins 8. Josuttis is silent disclosing a pivot wall section. However, Hurt discloses of placing a top wall section 16 on a hopper in order to preserve the moisture of tobacco in the hopper. At the time the invention was made it would have been obvious to a person of ordinary skill in the art to have provided top wall section 16 being pivotally mounted in order to readily open and close Josuttis' feed hopper in order to preserve tobacco moisture as taught by Hurt.

As for claim 14, the plucking roller having pins 8 would be removably.

Claims 13,15,26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Josuttis et al (US 4,572,216) in view of Hurt (US 4,164,229) and in further view of

Art Unit: 1731

Johnson (US 3,786,818). Josuttis and hurt are silent disclosing a non-corrosive plucking rollers. However in view that tobacco contains water that may corrode the roller and in view of Hurt teaching that tobacco container holding moist tobacco should be made of corrosion resistant material (Column 6, line 60ff), at the time the invention was made it would have been obvious to a person of ordinary skill in the art to have made Josuttis plucking roller of corrosion resistant material in order to prevent corrosion caused by moist tobacco as taught by Hurt.

As for claim 26, AlO_2 is a notoriously well known corrosion resistant finish.

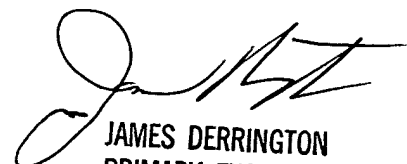
As for claim 13, providing anti-stick coating on tobacco contact surfaces is notoriously well known in order to prevent clumping of tobacco on the surfaces.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is (703) 605-1174. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7718 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.


JAMES DERRINGTON
PRIMARY EXAMINER
ART UNIT ~~137~~ 1731